



D-1221 R6

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:	)	
<b>Jeffrey Eastman, et al.</b>	)	
	)	Art Unit <b>2876</b>
Serial No.: <b>10/797,634</b>	)	
	)	
Confirm. No.: <b>6500</b>	)	
	)	
Filed: <b>March 10, 2004</b>	)	Primary Examiner
	)	<b>Karl D. Frech</b>
For: <b>Cash Dispensing Automated</b>	)	
<b>Banking Machine With Deposit</b>	)	
<b>Holding Container</b>	)	

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Commissioner for Patents  
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Alexandria, VA 22313-1450

**BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 41.37**

Sir:

The Appellants hereby submit their Appeal Brief pursuant to 37 C.F.R. § 41.37  
concerning the above-referenced Application.

**(i)**

**REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is Diebold Self-Service Systems, division of Diebold, Incorporated, an Ohio corporation.

(ii)

**RELATED APPEALS AND INTERFERENCES**

Appellants, Appellants' legal representative, and the Assignee of the present application are not aware of any prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or have a bearing on the Board's decision in the pending appeal.

(iii)

## STATUS OF CLAIMS

Claims 1-27 are pending in the Application.

Claims rejected: 1-27

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claims objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-27. These claim rejections were the only claim rejections present in the final Office Action (“Action”) dated August 25, 2006.

**(iv)**

**STATUS OF AMENDMENTS**

A final rejection was made August 25, 2006. No amendments to the claims were requested to be admitted after the final rejection.

(v) **SUMMARY OF CLAIMED SUBJECT MATTER**

*Concise explanations of exemplary forms of the claimed invention:*

**With respect to independent claim 1**

Claim 1 defines subject matter that is directed to an embodiment of a cash dispensing automated banking machine. As shown in Figures 1, 2 and 111, and discussed at page 58, line 20, to page 59, line 3, and page 54, lines 17-22, the automated banking machine (10) includes a chest (102), a cash dispenser (24) in operative connection with the chest, an acceptor device (26, 1100) in operative connection with an outer portion of the chest, a bracket (1190) in operative connection with an inner portion of the chest, and a deposit holding container (1104) movably engageable with the bracket.

In this embodiment as shown in Figure 112 and discussed at page 59, lines 4-11, the deposit holding container includes a reservoir (1106) and a door (1112) in operative connection with the reservoir. In addition, as shown in Figures 116-118 and discussed at page 62, line 11, to page 65, line 21, the deposit holding container includes a locking mechanism (1160) in operative connection with the reservoir. The locking mechanism is operative to change from a locked state to an armed state responsive to a key.

As discussed at page 62, line 20, to page 64, line 9, the locking mechanism includes a moveable portion (1168). When the moveable portion is moved, the locking mechanism is operative to change from an armed state to a locked state. As discussed at page 62, lines 15-18, when the locking mechanism is in the armed state, the door is moveable from a closed position to an open position.

In addition, as discussed at page 63, lines 4-7, and page 65, lines 1-4, when the container is moved into supporting engagement with the bracket, a first portion (1192) of the machine is operative to urge the moveable portion of the container to move. This causes the locking mechanism to change from the armed state to the locked state.

In this embodiment as discussed at page 65, lines 12-20, when the locking mechanism is in the locked state and the container is moved out of engagement with the bracket, a second portion (1198) of the machine is operative to urge the door of the container to move from the open position to the closed position. As discussed at page 63, lines 10-18, in the closed position, a portion of the door (1166) is in operative engagement with the locking mechanism. The locking mechanism in the locked state is operative to prevent the door from moving to an open position.

#### **With respect to independent claim 16**

Claim 16 defines subject matter that is directed to an embodiment of a method. As discussed at page 63, lines 4-7, and page 65, lines 1-4, and shown in Figures 1, 2, and 111-118, the method includes a step (a) of urging a deposit holding container (1104) to slide adjacent a bracket (1190) of an automated banking machine (10). As shown in Figures 1 and 2, the automated banking machine includes a cash dispenser (24).

As shown in Figures 112 and 116-118, and discussed at page 59, lines 4-11, and page 62, line 20 to page 65, line 21, in step (a) the container includes a door (1112) and a locking mechanism (1160) in an armed state. As discussed at page 62, lines 15-18, the door is operative

to move from a closed position to an open position when the locking mechanism is in the armed state.

Also, as discussed at page 63, lines 4-7 and page 65, lines 1-4, the method includes a step (b) of urging with a first portion (1192) of the automated banking machine the locking mechanism to change to a locked state responsive to step (a).

In addition, as discussed at page 65, lines 12-20, the method includes a step (c) of urging the container to slide out of the bracket. Also the method includes a step (d) of urging with a second portion (1198) of the automated banking machine, the door of the container to move to a closed position responsive to step (c). As discussed at page 63, lines 10-18, a portion (1166) of the door engages with the locking mechanism, which in the locked state is operative to prevent the door from moving to an open position.

#### **With respect to independent claim 24**

Claim 24 defines subject matter that is directed to an embodiment of a cash dispensing automated banking machine. As shown in Figures 1-6, and discussed at pages 6, line 6, to page 9, line 1, the automated banking machine includes a chest (102 ) in operative connection with a frame.

As discussed at page 67, lines 7-16, the chest has a generally "L" shaped outer contour with a first taller portion (1204) adjacent a second relatively shorter portion (1206). The shorter portion includes an upper face with an opening (1210) therethrough. The machine includes a cash dispenser (24) in operative connection within the taller portion of the chest and an acceptor device (26 1110), in operative connection with an outer portion of the chest. The acceptor device



is positioned above the shorter portion and adjacent to the first taller portion. In addition, the machine includes a deposit holding container (1104) in removable connection within the shorter portion of the chest. The acceptor device is operative to move items through the opening into the container. An example of the deposit holding container operative for use with an "L" shaped chest is shown in Figures 110-118 and described at page 58, line 20, to page 65, line 20.

**With respect to independent claim 25**

Claim 25 defines subject matter that is directed to an embodiment of a method. As discussed at page 63, lines 4-7 and page 65, lines 1-4 and shown in Figures 1, 2, and 111-118, the method includes a step (a) of urging a deposit holding container (1104) to slide into a chest (102) of an automated banking machine (10). As shown in Figures 1, 2, and 111, the automated banking machine includes a cash dispenser (24) and a deposit accepting device (26, 1100).

As shown in Figures 112 and 116-118, and discussed at page 59, lines 4-11 and page 62, line 20 to page 65, line 21, the deposit holding container includes a locking mechanism (1160) and a door (1112) controlling access to an interior area (1106) of the container. As discussed at page 62, lines 15-18, in step (a) the locking mechanism is in a first state which permits the door to move from a closed position to an open position. Also as discussed at page 65, lines 5-11, the door is moved from the closed position to the open position responsive to the container sliding into the chest.

In addition, as discussed at page 63, lines 4-7, and page 65, lines 1-4, the method includes a step (b) in which responsive to the container sliding into the chest in step (a), the method includes a step of urging through operative engagement with a portion (1192) of the automated

banking machine, the locking mechanism to change from the first state to a second state. As discussed at page 63, lines 10-18, with the locking mechanism in the second state the door will be held closed by the locking mechanism when the door is next moved to the closed position.

Further, as discussed at page 65, lines 12-20, the method includes a step (c) in which subsequent to step (b) the method includes urging the container to slide out of the chest. Also, the method includes a step (d) in which responsive to step (c) the method includes urging through engagement with a portion (1198) of the automated banking machine, the door of the deposit holding container to move from the open position to the closed position. As discussed at page 63, lines 10-18, when the door has moved to the closed position, the locking mechanism in the second state prevents the door from thereafter moving from the closed position to the open position.

**(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds to be reviewed in this appeal are:

Whether Appellants' claims 1 - 27 are obvious under 35 U.S.C. § 103(a) over Lee, U.S.

Publication No. 2003/0120973 in view of Mariotti, U.S. Patent No. 1,924,365.

(vii)

## **ARGUMENT**

### **The Lee Reference**

The Lee reference is directed to a media dispenser module for an ATM that has a locking mechanism. The locking mechanism is described in paragraphs [0035] to [0039] and Figures 1-3 for a first embodiment and in paragraphs [0056] to [0059] and Figures 7 and 8 for a second embodiment.

### **The Mariotti Reference**

The Mariotti reference is directed to a lock (38) for a door (14) of a vault. Mariotti indicates that a key must be used to lock the door in the closed position (Page 2, lines 69-80). Also, Mariotti teaches that the key is intended to only be used by authorized persons (Column 1, line 10).

## **The 35 U.S.C. § 103 (a) Rejections**

### **The Applicable Legal Standards**

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

**Rejection under 35 U.S.C. § 103(a) over Barabash in view of Adirondack and UVA**

In the Action, claims 1-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Mariotti. These rejections are respectfully traversed.

**Claim 1**

Claim 1 is an independent claim directed to a cash dispensing automated banking machine that includes a deposit holding container including a locking mechanism. The Action acknowledges that Lee does not disclose a key locking mechanism. However, the Action asserts that Mariotti discloses a housing with an interior portion, reservoir, and a sliding door which is locked by means of a key. The Action then states that "it would have been obvious . . . to use a key lock on the ATM of Lee. This would provide for a positive mechanical lock on the door hindering any attempt to physically pry open the door."

Appellants respectfully disagree that it would be obvious to combine Lee and Mariotti in the manner suggested in the Action. However, whether or not it would be obvious to combine Lee and Mariotti (which it is not), Appellants respectfully submit that the combination of Lee and Mariotti still fails to disclose or suggest each of the features and relationships recited in the claim.

Claim 1 recites a locking mechanism on a deposit holding container that is operative to change from **a locked state to an armed state responsive to a key**. A key is used to place the locking mechanism of the recited container in the recited "armed state". The applied art does not disclose or suggest an "armed state" of a locking mechanism. Further, nowhere does the applied art disclose or suggest any other state of a locking mechanism which includes the features of an "armed state" as recited in claim 1.

In the armed state, the door of the container is capable of moving from a closed position to an open position so that deposited items may be placed into the container through operation of an accepting device. In claim 1, the recited container in the armed state is engaged with a bracket inside the chest of the automated banking machine. As the container moves in engagement with the bracket, a first portion of the machine urges a moveable portion on the container to move to cause the locking mechanism to change from an armed state to a locked state (while the door is open). Then as the container is removed and moves out of engagement with the bracket, a second portion of the machine is operative to urge the door of the container to move from the open position to the closed position. Movement of the door to the closed position engages the door with the locking mechanism. The locking mechanism (which was previously placed in the locked state before the door was closed) now prevents the door from moving to an open position.

The Action appears on page 3, line 8 to suggest that an unlocked state of Mariotti corresponds to the armed state recited in claim 1. Appellants respectfully disagree. Claim 1 specifically recites that:

**wherein when the container is moved into supporting engagement with the bracket:  
a first portion of the machine is operative to urge the movable portion of the  
container to move, whereby the locking mechanism is changed from the armed state  
to the locked state.**

Mariotti does not disclose or suggest that its lock operates in this manner. Nowhere does Mariotti disclose or suggest that its lock, (in an unlocked state) is capable of changing to a locked state by moving a container into a bracket which urges a moveable portion of its described lock. Rather, Mariotti specifically teaches that a key must be used to lock the door (Page 2, lines 63-80). Mariotti does not disclose or suggest an alternative way of changing a state of its lock using a bracket and a moveable portion of the lock. Thus the unlocked state of Mariotti's lock cannot correspond to the "armed state" recited in claim 1.

Further Mariotti teaches that the key must be used to lock the door "in closed position" (Page 2, lines 69-80). In contrast, claim 1 specifically recites that:

**wherein when the locking mechanism is in the locked state and the container is moved out of engagement with the bracket, a second portion of the machine is operative to urge the door of the container to move from the open position to the closed position, wherein in the closed position, a portion of the door is in operative engagement with the locking mechanism, wherein the locking mechanism in the locked state is operative to prevent the door from moving to an open position.**

The lock in Mariotti is not capable of having these recited features. The lock in Mariotti cannot be in a locked state prior to being closed and still enable the door to be locked when moved to a closed position.



As shown in Figures 2 and 3 and described on page 2, lines 75-80 of the present application, the door must be in the closed position (with the apertures 43 and 46 aligned) to enable the plunger (41) of the lock to project upward into the apertures (43, 46) to lock the door in the closed position. In contrast, placing Mariotti's lock in a locked state prior to closing the door would prevent Appellants' aperture (43) from moving into alignment with the aperture (46) and plunger (41) and therefore would prevent the door from being locked. Consequently, Mariotti's "unlocked state" cannot correspond to either the recited "armed state" or "locked state".

Neither Lee nor Mariotti discloses or suggests a locking mechanism that has Appellants' recited armed state. Further, neither reference discloses or suggests a locking mechanism that changes from the armed state to a locked state without using key, while the door is open. Further, neither Lee nor Mariotti discloses or suggests a door of a deposit holding container that is locked in a closed position by moving the container into and out of engagement with a bracket inside a chest of an automated banking machine.

In use of Appellants' recited invention, a person retrieving the recited deposit holding container from the automated banking machine does not require access to a key to the container to close and lock it. Rather, the configuration of the exemplary machine as recited in claim 1 automatically closes and locks the container when it is removed from the chest. Thus the person removing a full deposit holding container from the automated banking machine can transport the container in a locked state without the need for the person to have a key to the container. Because the person removing the deposit holding container no longer needs a key to close and lock the deposit holding container, there is less risk that items can be stolen.

Neither reference discloses or suggests a deposit holding container in an automated banking machine with these features. Again Mariotti teaches away from these features by requiring a key to be used to lock the door in the closed position (Page 2, line 80). A reference teaching away from the recited invention does not support *prima facie* obviousness. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1598-99 (Fed. Cir. 1988).

Thus with respect to claim 1, neither reference discloses or suggests a locking mechanism on a deposit holding container that is operative to change from **a locked state to an armed state responsive to a key**, wherein the door is moveable from a closed position to an open position in the armed state. In addition, neither reference discloses or suggests that when the container is moved **into** engagement with the bracket **a first portion of the machine is operative to urge the moveable portion of the container** to move which causes the locking mechanism **to change from an armed state to a locked state**. In addition, neither reference discloses or suggests that when the container is moved **out of** engagement with the bracket **a second portion of the machine is operative to urge the door of the container to move from the open position to the closed position** which engages the door with the locking mechanism (already in the locked state) and prevents the door from moving to an open position.

The applied references do not disclose or suggest each of the features and relationships recited in the claim. Thus the Office has not established *prima facie* obviousness. On this basis the rejection of claim 1 should be reversed.

In addition, even if the applied art did disclose or suggest each of the features recited in claim 1 (which they do not), it would still not be obvious to combine Lee with Mariotti as asserted in the Action. For example, Lee is directed to a media dispenser module for an ATM that has a locking mechanism (described in paragraphs [0035] and [0039] for a first embodiment and in paragraph [0056] to [0059] for a second embodiment). There is no teaching, suggestion, or motivation to include a key lock on the door (20) in addition to the described "secure locking mechanism". Further, the addition of such a key lock would defeat the utility or advantages of Lee's invention. The ATM is designed to automatically slide down (open) the door (20) when media requested by the user is piled on the media mounting portion (12) (Figure 1, paragraphs [0033] to [0036]). Placing a key lock on the door would require each user to have a key. Nowhere do Lee or Mariotti disclose or suggest ATMs which require a physical key to access cash dispensed by the ATMs. Further, providing physical keys to users of the ATM would defeat the alleged security provided by a key lock, because everyone (including thieves) could have a copy of the key. Although Mariotti discloses a key lock 38, the key of Mariotti is intended to only be used by authorized persons (Column 1, line 10). Neither Lee nor Mariotti discloses or suggests providing an ATM or a vault with a key lock usable by the general public to access dispensed cash.

Thus it would not be obvious to combine Lee with Mariotti as asserted by the Office. Further, even if there were a prior art teaching or suggestion to combine Lee and Mariotti as asserted, the claims are not directed to a consumer accessible dispensing mechanism which includes a keylock. Rather the claims are directed to unique features and operation of a deposit holding container which slides in supporting connection with a bracket inside a secure chest of an

automated banking machine. Thus the asserted theoretical combination of features in Lee and Mariotti does not correspond to the features recited in Appellants' claim.

Further, even if there were a prior art teaching or suggestion to combine Lee and Mariotti (which there is not), at best such a combination would only produce an ATM with a vault that includes a key usable to both lock and unlock the vault. This hypothetical combination does not correspond to the specific features associated with the deposit holding container recited in claim as discussed above.

The applied references do not disclose or suggest each of features and relationships recited in the claim, and the Office has not established *prima facie* obviousness. Also, as nothing in the cited art discloses or suggests the features and relationships that are specifically recited in the claim, and because there is no prior art teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that claim 1 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be reversed. It follows that the rejections of claims 2-15 which depend from claim 1 should also be reversed.

## **Claim 2**

Claim 2 depends from claim 1 and recites that a third portion of the automated banking machine is operative to urge the door of the container to slide into the open position when the locking mechanism is in the armed position; the door of the container is in the closed state; and the container is moved into engagement with the bracket.

The applied references do not disclose or suggest these features. Neither Lee nor Mariotti discloses or suggests a portion of an automated banking machine that is operative to urge a door of a container to slide from a closed state to an open position when the container is moved into engagement with a bracket.

As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 2 should be reversed.

### **Claim 3**

Claim 3 depends from claim 1 and recites that the locking mechanism is operative to accept a key therein. Also, claim 3 recites that when the key rotates in a first direction, the key is operative to cause the locking mechanism to change to an unlocked state in which the door is moveable from the closed position to the open position.

The applied references do not disclose or suggest these features. Neither Lee nor Mariotti discloses or suggests a locking mechanism that is capable of being changed between the three different states of: an "armed state", a "locked state", and an "unlocked state".

As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 3 should be reversed.

### **Claim 4**

Claim 4 depends from claim 1 and recites that the locking mechanism is operative to accept a key therein. Also, claim 4 recites that when the key rotates in a first direction, the key is operative to cause the locking mechanism to change to an unlocked state in which the door is

moveable from the closed position to the open position. In addition, claim 4 recites that after changing to the unlocked state, when the key rotates in a second direction opposed of the first direction, the locking mechanism is operative to change to the armed state.

The applied references do not disclose or suggest these features. Neither Lee nor Mariotti discloses or suggests a locking mechanism that is capable of being changed between the three different states of: an "armed state", a "locked state", and an "unlocked state". Further, neither reference discloses or suggests a locking mechanism that changes to an unlocked state when the key is rotated on one direction and changes to an armed state when a key is rotate in an opposite direction.

As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 4 should be reversed.

#### **Claim 5**

Claim 5 depends from claim 4 and recites that after the key is rotated in the first direction within the locking mechanism, the locking mechanism is operative to prevent the key from being removed from the locking mechanism, until the key is rotated in the second direction. Neither Lee nor Mariotti discloses or suggests a locking mechanism in which a key in the locking mechanism is unable to be removed when the locking mechanism is in an unlocked state.

As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 5 should be reversed.

### **Claim 6**

Claim 6 depends from claim 4 and recites that the acceptor device is operative to move to a position above the bracket. The chest includes at least one opening therethrough located adjacent the bracket, wherein the acceptor device is operative to move items through the opening into the container.

Neither Lee nor Mariotti discloses or suggests an acceptor device outside a chest that moves to a position above a bracket located inside the chest, which bracket receives a deposit holding container. Further, neither reference discloses or suggests a deposit acceptor device that moves items into the container through an opening in the chest and adjacent the bracket.

As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 6 should be reversed.

### **Claim 7**

Claim 7 depends from claim 6 and recites that automated banking machine further comprises a moveable projection. When the container is moved into engagement with the bracket, the container is operative to urge the moveable projection into a first position adjacent a portion of the acceptor device. The moveable projection in the first position is operative to prevent the acceptor device from moving into a service position. In addition, when the container is removed from engagement with the bracket, the moveable projection is operative to move to a second position. The moveable projection in the second position does not prevent the acceptor device from moving into the service position.

The applied art does not disclose or suggest a moveable projection with these recited features. Nowhere does Lee or Mariotti disclose or suggest that when a container is moved into engagement with a bracket, the container is operative to urge a moveable projection into a first position adjacent a portion of an acceptor device. In addition nowhere do the applied references disclose or suggest that when the container is removed out of engagement with the bracket, the moveable projection is operative to move to a second position. Further neither reference discloses or suggests that: the moveable projection in the first position is operative to prevent the acceptor device from moving into a service position; and the moveable projection in the second position does not prevent the acceptor device from moving into the service position.

As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 7 should be reversed.

#### **Claim 8**

Claim 8 depends from claim 7 and recites that when the acceptor device is not in the service position, the acceptor device is positioned above the bracket. In addition claim 8 recites that when the acceptor device is in the service position, the acceptor device is not directly above at least a portion of the at least one opening through the chest.

Neither Lee nor Mariotti discloses or suggests an acceptor device which is capable of moving to a service position. Further the applied art says nothing about the position of an acceptor device when in a service position relative an opening in a chest.

As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 8 should be reversed.



### **Claim 9**

Claim 9 depends from claim 1 and recites that the chest has a generally "L" shaped contour with a first taller portion adjacent a second relatively shorter portion. Claim 9 also recites that the acceptor device is positioned above the shorter second portion adjacent the first taller portion. In addition claim 9 recites that the bracket is positioned within the second shorter portion of the chest below the acceptor device. Also, the chest includes an opening between the bracket and the acceptor device and the acceptor device is operative to move items through the opening into the container.

Neither Lee nor Mariotti discloses or suggests a chest of an automated banking machine with the configuration recited in claim 9. For example, neither reference discloses or suggests a chest that includes a generally "L" shaped contour with a first taller portion adjacent a second relatively shorter portion. In addition, neither reference discloses or suggests an automated banking machine with an acceptor device that is positioned above the shorter second portion adjacent the first taller portion of the chest. Further the applied art does not disclose or suggest an automated banking machine with a bracket that is positioned within the second shorter portion of the chest below the acceptor device. Also, the applied art does not disclose or suggest an opening in the chest between the bracket and the acceptor device, through which the acceptor device move items into the container.

As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 9 should be reversed.

### **Claim 10**

Claim 10 depends from claim 1 and recites that the door of the container includes an upwardly directed projection. When the container is moved into supporting engagement with the bracket the second portion of the machine is operative to contact the upwardly directed projection to urge the door to move into the open position.

Neither Lee nor Mariotti discloses or suggests a container with an upwardly directed projection that is contacted when moved into a bracket by a portion of the machine to urge a door of the container to move into an open position.

As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 10 should be reversed.

### **Claim 11**

Claim 11 depends from claim 2 and recites that the door of the container includes a slot. When the container is moved out of engagement with the bracket, the third portion of the machine is operative to pivot into the slot and urge the door into the closed position.

Nowhere does the applied art disclose or suggest a portion of an automated banking machine that pivots into a slot of a deposit holding container and urges a door of the container into a closed position when the container is moved out of engagement with a bracket in the machine.

As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 11 should be reversed.

### **Claim 12**

Claim 12 depends from claim 1 and recites that the container includes a frame with an aperture therethrough adjacent the moveable portion. The locking mechanism is mounted in supporting connection with the frame. The first portion of the automated banking machine includes a pin which is positioned to extend in the aperture and engage the moveable portion when the container is moved into supporting engagement with the bracket.

Nowhere does the applied art disclose or suggest a pin of an automated banking machine which is operative to extend through an aperture in a frame of the container to engage a moveable portion when the container is moved into a bracket. Further nowhere does the applied art disclose or suggest that engagement of the moveable portion with the pin causes a locking mechanism of the container to change from an armed state to a locked state.

As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 12 should be reversed.

### **Claim 13**

Claim 13 depends from claim 1 and recites that the door includes a flexible tambour portion which is operative to slide between parallel channels adjacent an opening into the reservoir.

Nowhere does the applied art disclose or suggest a deposit holding container that includes a door with a flexible tambour portion operative to slide between parallel channels.

As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 13 should be reversed.

#### **Claim 14**

Claim 14 depends from claim 13 and recites that the tambour door includes flanges which are operative to slide within the channels.

Nowhere does the applied art disclose or suggest a deposit holding container that includes a tambour door with flanges operative to slide within channels. As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 14 should be reversed.

#### **Claim 15**

Claim 15 depends from claim 14 and recites that each channel includes a frangible portion operative to break to provide an opening for inserting one of the flanges of the door into the channel.

Nowhere does the applied art disclose or suggest a deposit holding container that includes channels with frangible portions operative to break to provide an opening for inserting the flanges of a door. As nothing in the applied art discloses or suggests all of the features and relationships recited in the claim, it is respectfully submitted that the rejection of claim 15 should be reversed.

#### **Claim 16**

Claim 16 is an independent claim directed to a method that involves a deposit holding container of an automated banking machine. In claim 16, a first portion of the automated banking machine urges a locking mechanism of the deposit holding container to change from an

armed state to a locked state responsive to a step of urging the container to slide adjacent a bracket of the machine. Also a second portion of the automated banking machine urges the door of the deposit holding container to move to a closed position responsive to a step of urging the deposit holding container to slide out of the bracket. This causes the door to engage with the locking mechanism in the locked state and prevents the door from moving to an open position.

As discussed previously, the Action at page 3, line 8, appears to suggest that an unlocked state of Mariotti corresponds to the "armed state" recited in claim 16. Appellants respectfully disagree. For example, claim 16 specifically recites:

**(a) urging a deposit holding container to slide adjacent a bracket of an automated banking machine, . . . wherein the container includes a locking mechanism . . . in an armed state, . . .**

**(b) urging with a first portion of the automated banking machine the locking mechanism to change to a locked state responsive to (a);**

Mariotti does not disclose or suggest that its lock operates in this manner. Nowhere does Mariotti disclose or suggest that its lock, (in an unlocked state) is capable of being urged to change to a locked state responsive to urging a container to slide adjacent a bracket. Rather, Mariotti specifically teaches that a key must be used to lock the door (Page 2, lines 63-80). Mariotti does not disclose or suggest an alternative way of changing a state of its lock by urging a container to slide adjacent a bracket. Thus the unlocked state of Mariotti's lock cannot correspond to the "armed state" recited in claim 16.

Further Mariotti teaches that the key must be used to lock the door "in closed position" (Page 2, lines 69-80).

In contrast, claim 16 specifically recites that:

**c) urging the container to slide out of the bracket; and**

**d) urging with a second portion of the automated banking machine, the door of the container to move to a closed position responsive to (c), wherein a portion of the door engages with the locking mechanism, wherein the locking mechanism in the locked state is operative to prevent the door from moving to an open position.**

The lock in Mariotti is not capable of having these recited features. The lock in Mariotti cannot be in a locked state prior to being closed and still enable the door to be locked when moved to a closed position. As shown in Figures 2 and 3 and described on page 2 lines 75-80 of Appellants' application, the door must be in the closed position (with the apertures 43 and 46 aligned) to enable the plunger (41) of the lock to project upward into the apertures (43, 46) to lock the door in the closed position. Placing Mariotti's lock in a locked state prior to closing the door would prevent Appellants' aperture (43) from moving into alignment with the aperture (46) and plunger (41) and therefore would prevent the door from being locked. Consequently, Mariotti's "unlocked state" cannot correspond to either the recited "armed state" or "locked state".

Neither Lee nor Mariotti discloses or suggest a locking mechanism that is capable of being in the recited "armed state". Further, neither reference discloses or suggests a locking

mechanism that is capable of being urged to change from the armed state to a locked state responsive to urging a deposit holding container to slide adjacent a bracket. In addition, neither Lee nor Mariotti discloses or suggests a portion of a banking machine that changes a state of a lock as a deposit holding container is slid into the bracket. Also, neither reference discloses or suggests a locking mechanism that is capable of being urged to change from the armed state to a locked state before the door is urged to a closed position. In addition, neither Lee nor Mariotti discloses or suggests a door of a deposit holding container that is locked by urging the container into and out of engagement with a bracket of an automated banking machine.

In use of Appellants' recited invention, a person retrieving the deposit holding container from the automated banking machine does not require access to a key to the container to close and lock it. Rather, the configuration of the exemplary machine as recited in claim 16, automatically closes and locks the container when it is urged out of engagement with the bracket. Thus the person removing a full deposit holding container from the automated banking machine can transport the container in a locked state without the need for this person to have a key to the container. Because the person removing the deposit holding container does not need a key to close and lock the deposit holding container, there is less risk that items can be stolen.

Neither reference discloses or suggests a deposit holding container in an automated banking machine with these features. Again Mariotti teaches away from these features by requiring a key to be used to lock the door in the closed position (Page 2, line 80). A reference teaching away from the recited invention does not support *prima facie* obviousness. An obviousness rejection cannot be based on a combination of features in references if making the

combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1598-99 (Fed. Cir. 1988).

Thus with respect to claim 16, neither reference discloses or suggests: urging a deposit holding container with a locking mechanism in an armed state **to slide adjacent a bracket of an automated banking machine**. Further, neither reference discloses or suggests that a door of the container is operative **to move from a closed position to an open position when the locking mechanism is in the armed state**. In addition, neither reference discloses or suggests **urging with a first portion** of the automated banking machine **the locking mechanism to change to a locked state responsive to** urging the container to slide adjacent a bracket of the machine. Further, neither reference discloses or suggests **urging, with a second portion** of the automated banking machine, the door of the container **to move to a closed position responsive to urging the container to slide out of the bracket**. Also, neither reference discloses or suggests that in the step of closing the door with a locking mechanism already in a locked state, the locking mechanism in the locked state **is operative to prevent the door from moving to an open position**.

The applied references do not disclose or suggest each of the features, relationships, and steps recited in the claim. Thus the Office has not established *prima facie* obviousness. On this basis the rejection of claim 16 should be reversed.

In addition, even if the applied art did disclose or suggest each of the features recited in claim 16 (which it does not), it would still not be obvious to combine Lee with Mariotti as argued in the Action. For example, Lee is directed to a media dispenser module for an ATM that has a locking mechanism (described in paragraphs [0035] and [0039] for a first embodiment and in



paragraph [0056] to [0059] for a second embodiment). There is no teaching, suggestion, or motivation to include a key lock on the door (20) in addition to the described "secure locking mechanism". Further, the addition of such a key lock would defeat the utility or advantages of Lee's invention. The ATM is designed to automatically slide down (open) the door (20) when media requested by the user is piled on the media mounting portion (12) (Figure 1, paragraphs [0033] to [0036]). Placing a key lock on the door would require each user to have a key.

Nowhere do Lee or Mariotti disclose or suggest ATMs which require a physical key to access cash dispensed by the ATMs. Further, providing physical keys to users of the ATM would defeat the alleged security provided by a key lock, because everyone (including thieves) could have a copy of the key. Although Mariotti discloses a key lock 38, the key of Mariotti is intended to only be used by authorized persons (Column 1, line 10). Neither Lee nor Mariotti discloses or suggests providing an ATM or a vault with a key lock usable by the general public to access dispensed cash.

Thus it would not be obvious to combine features of Lee with Mariotti as asserted by the Office. Further, even if there were a prior art teaching or suggestion to combine Lee and Mariotti as asserted, the claims are not directed to a consumer accessible dispensing mechanism which includes a keylock. Rather the claims are directed to the steps of using a deposit holding container which slides in into and out of engagement with a bracket in an automated banking machine. Thus the asserted combination of features in Lee and Mariotti does not correspond to the features recited in Appellants' claims.

Further, even if there were a prior art teaching or suggestion to combine Lee and Mariotti (which there is not), at best such a combination would only produce an ATM with a vault that

includes a key usable to both lock and unlock the vault. This hypothetical combination is not capable of being used to carry out the specific steps associated with the deposit holding container recited in claim, as discussed above, in which a key is not used to lock a door of the deposit holding container.

The applied references do not disclose or suggest each of the features, relationships, and steps recited in the claim and the Office has not established *prima facie* obviousness. Also, as nothing in the cited art discloses or suggests the features, relationships, and steps that are specifically recited in the claim, and because there is no prior art teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that claim 16 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be reversed. It follows that the rejections of claims 17-23 which depend from claim 16 should likewise be reversed.

#### **Claim 17**

Claim 17 depends from claim 16 and recites that prior to (a) the door of the container is in the closed position. In addition claim 17 recites that the method comprises responsive to (a), urging with a third portion of the automated banking machine the door of the container to slide into the open position.

Nowhere does the applied art disclose or suggest a step of urging with a portion of an automated banking machine, a door of a deposit holding container to slide into an open position responsive to urging the deposit holding container to slide adjacent a bracket of the automated banking machine. As nothing in the applied art discloses or suggests all of the features,

relationships, and steps recited in the claim, it is respectfully submitted that the rejection of claim 17 should be reversed.

#### **Claim 18**

Claim 18 depends from claim 16 and recites that the method further includes a step (e) of placing a key into engagement with the locking mechanism. In addition claim 18 recites that the method includes a step (f) of urging with the key the locking mechanism into an unlocked state in which the door is operative to move to the open position.

Neither Lee nor Mariotti discloses or suggests a locking mechanism that is capable of being changed between the three different states of: an "armed state", a "locked state", and an "unlocked state". Nowhere does the applied art disclose or suggest steps of urging a locking mechanism to change from an armed state to a locked state and urging the locking mechanism into an unlocked state.

As nothing in the applied art discloses or suggests all of the features, relationships, and steps recited in the claim, it is respectfully submitted that the rejection of claim 18 should be reversed.

#### **Claim 19**

Claim 19 depends from claim 18 and recites that the method further includes a step (g) of removing the key from engagement with the locking mechanism. Claim 19 also recites that in step (g) the locking mechanism is in the armed state.

Nowhere does the applied art disclose or suggest a locking mechanism which is ever in an armed state. As nothing in the applied art discloses or suggests all of the features, relationships, and steps recited in the claim, it is respectfully submitted that the rejection of claim 19 should be reversed.

#### **Claim 20**

Claim 20 depends from claim 18 and recites that the method further includes a step (g) of causing with the key, the locking mechanism to change from the unlocked state to the armed state. In addition claim 20 recites that the method includes a step (h) of removing the key from engagement with the locking mechanism.

Nowhere does the applied art disclose or suggest a locking mechanism which is capable of changing from an unlocked state to an armed state with a key. As nothing in the applied art discloses or suggests all of the features, relationships, and steps recited in the claim, it is respectfully submitted that the rejection of claim 20 should be reversed.

#### **Claim 21**

Claim 21 depends from claim 20 and recites that between (f) and (g) the key is not removable from the locking mechanism.

Nowhere does the applied art disclose or suggest a locking mechanism in which a key is not capable of being removed until the locking mechanism is changed from an unlocked state to an armed state. As nothing in the applied art discloses or suggests all of the features,

relationships, and steps recited in the claim, it is respectfully submitted that the rejection of claim 21 should be reversed.

#### **Claim 22**

Claim 22 depends from claim 20 and recites that step (f) includes rotating the key within the locking mechanism in a first direction.

The applied art does not disclose or suggest urging with the key the locking mechanism into an unlocked state by rotating the key in a first direction and then causing with the key, the locking mechanism to change from the unlocked state to the armed state. As nothing in the applied art discloses or suggests all of the features, relationships, and steps recited in the claim, it is respectfully submitted that the rejection of claim 22 should be reversed.

#### **Claim 23**

Claim 23 depends from claim 20 and recites that step (f) includes rotating the key within the locking mechanism in a first direction.

The applied art does not disclose or suggest urging with the key the locking mechanism into an unlocked state by rotating the key in a first direction and then causing with the key, the locking mechanism to change from the unlocked state to the armed state. As nothing in the applied art discloses or suggests all of the features, relationships, and steps recited in the claim, it is respectfully submitted that the rejection of claim 23 should be reversed.

#### **Claim 24**

Claim 24 is an independent claim directed to a cash dispensing automated banking machine. Neither Lee nor Mariotti discloses or suggests the following features recited in claim 24:

- **a chest in operative connection with a frame, wherein the chest has a generally "L" shaped outer contour with a first taller portion adjacent a second relatively shorter portion;**
- **the shorter portion including an upper face with an opening therethrough;**
- **a cash dispenser in operative connection within the taller portion of the chest;**
- **an acceptor device in operative connection with an outer portion of the chest;**
- **wherein the acceptor device is positioned above the shorter portion;**
- **wherein the acceptor device is positioned . . . adjacent to the first taller portion;**
- **a deposit holding container in removable connection within the shorter portion of the chest;**
- **wherein the acceptor device is operative to move items through the opening into the container.**

Neither Lee nor Mariotti discloses or suggests an acceptor device. The Action contends that Official Notice is taken that means to allow media to be input into an ATM is old and well known and that it would have been obvious to include a media input means in the ATM of Lee

to allow for customer deposits. However, regardless of whether the alleged means to allow media to be input into an ATM is old, the Action has still failed to establish prior art evidence of the recited arrangement of an acceptor device with respect to a chest as recited in claim 24.

For example, neither reference discloses or suggests a chest of an automated banking machine, which chest has a **generally "L" shaped outer contour**. In addition, neither reference discloses or suggests that a shorter portion of the "L" shaped chest **includes an upper face with an opening therethrough**. Also, neither reference discloses or suggests that the acceptor device **is positioned above the shorter portion and is operative to move items through the opening**.

In addition to not disclosing or suggesting these recited features regarding a chest and an acceptor device, Lee and Mariotti also do not disclose or suggest a deposit holding container **in removable connection within the shorter portion of the chest**. In addition, neither reference discloses or suggests an acceptor device which is operative to move items through the opening in the upper face of the shorter portion and **into the container**.

The applied references do not disclose or suggest each of features and relationships recited in the claim and the Office has not established *prima facie* obviousness. Also, as nothing in the cited art discloses or suggests the features and relationships that are specifically recited in the claim, and because there is no prior art teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that claim 24 is allowable for these reasons. Therefore it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 24 should be reversed.

### **Claim 25**

Claim 25 is an independent claim directed to a method involving a deposit holding container of an automated banking machine. In claim 25, a door of the deposit holding container opens and a portion of the automated banking machine urges a locking mechanism of the deposit holding container to change from a first state to a second state, responsive to a step of urging the deposit holding container to slide into a chest of the machine. The locking mechanism in the first state permits the door to move from a closed position to an open position. Also a portion of the automated banking machine urges the door of the deposit holding container to move to a closed position responsive to a step of urging the container to slide out of the chest. When the door has moved to the closed position, the locking mechanism in the second state prevents the door from thereafter moving from the closed position to the open position.

Appellants respectfully submit that the recited "first state" of the locking mechanism does not correspond to the unlocked state of Mariotti's lock. For example, claim 25 specifically recites:

- a) urging a deposit holding container to slide into a chest of an automated banking machine, . . . wherein the deposit holding container includes a locking mechanism . . . in a first state which permits the door to move from a closed position to an open position . . .**
- b) responsive to the container sliding into the chest in (a), urging through operative engagement with a portion of the automated banking machine, the**



**locking mechanism to change from the first state to a second state, wherein with the locking mechanism in the second state the door will be held closed by the locking mechanism when the door is next moved to the closed position**

Mariotti does not disclose or suggest that its lock operates in this manner. Nowhere does Mariotti disclose or suggest that its lock, (in an unlocked state) is capable of being urged to change from the recited first state to the recited second state responsive to urging a deposit holding container to slide into a chest. Rather Mariotti specifically teaches that a key must be used to lock the door (Page 2, lines 63-80). Mariotti does not disclose or suggest an alternative way of changing a state of its lock by urging a container to slide into a chest. Thus the unlocked state of Mariotti's lock cannot correspond to the "first state" recited in claim 25.

Further Mariotti teaches that the key must be used to lock the door "in closed position" (Page 2, lines 69-80). In contrast, claim 25 specifically recites that:

- c) subsequent to (b), urging the container to slide out of the chest; and**
- d) responsive to (c), urging through engagement with a portion of the automated banking machine, the door of the deposit holding container to move from the open position to the closed position, wherein when the door has moved to the closed position, the locking mechanism in the second state prevents the door from thereafter moving from the closed position to the open position.**

Here claim 25 recites that steps (c) and (d) of closing and locking the door are carried out after the steps of opening the door and changing the lock mechanism from the first state to the second state. The lock in Mariotti is not capable of having these recited features. The lock in Mariotti cannot be in a locked state prior to being closed and still enable the door to be locked when moved to a closed position. For example, as shown in Figures 2 and 3 and described on page 2 lines 75-80, the door must be in the closed position (with the apertures 43 and 46 aligned) to enable the plunger (41) of the lock to project upward into the apertures (43, 46) to lock the door in the closed position. Placing Mariotti's lock in a locked state prior to closing the door would prevent the aperture (43) from moving into alignment with the aperture (46) and plunger (41) and therefore would prevent the door from being locked. Consequently, Mariotti's "unlocked state" cannot correspond to either the recited "first state" or "second state".

Neither Lee nor Mariotti discloses or suggests a locking mechanism that is capable of being in the recited "first state". Further, neither reference discloses or suggests a locking mechanism that is capable of being urged to change from the first state to the second state responsive to urging a deposit holding container to slide into a chest. In addition, neither Lee nor Mariotti discloses or suggests a portion of a banking machine that changes a state of a lock as a deposit holding container is slid into the chest. Also, neither reference discloses or suggests a locking mechanism that is capable of being urged to change from the first state to the second state when the door is open. In addition, neither Lee nor Mariotti discloses or suggests a door of a deposit holding container that is locked by urging the container into and out of a chest of an automated banking machine.

In use of the recited invention, a person retrieving the deposit holding container from the automated banking machine does not require access to a key of the deposit holding container to close and lock it. Rather, the configuration of the exemplary machine as recited in claim 25 automatically closes and locks the container when it is urged out of engagement with the bracket. Thus the person removing a full deposit holding container from the automated banking machine can transport the container in a locked state without the need for this person to have a key to the container. Because the person removing the deposit holding container does not need a key to close and lock the deposit holding container, there is less risk that items can be stolen.

Neither reference discloses or suggests a deposit holding container in an automated banking machine with the recited features. Again Mariotti teaches away from these features by requiring a key to be used to lock the door in the closed position (Page 2, line 80). A reference teaching away from the recited invention does not support *prima facie* obviousness. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1598-99 (Fed. Cir. 1988).

Thus with respect to claim 25, neither reference discloses or suggests: urging a deposit holding container with a locking mechanism in a first state **to slide into a chest of an automated banking machine**. Also, neither reference discloses or suggests a door of a deposit holding container that moves from the closed position to the open position **responsive to the container sliding into the chest**. In addition, neither reference discloses or suggests **urging** through operative engagement with a portion of the automated banking machine, **the locking mechanism to change from the first state to a second state** responsive to the container **sliding into the**

**chest.** Further, neither reference discloses or suggests **urging** through engagement with a portion of the automated banking machine, **the door of the deposit holding container to move from the open position to the closed position responsive to urging the container to slide out of the chest.** Also, neither reference discloses or suggests that in a step of closing the door with a locking mechanism already in a second state, when the door has moved to the closed position, the locking mechanism in the second state prevents the door from thereafter moving from the closed position to the open position.

The applied references do not disclose or suggest each of the features, relationships, and steps recited in the claim. Thus the Office has not established *prima facie* obviousness. On this basis the rejection of claim 25 should be reversed.

In addition, even if the applied art did disclose or suggest each of the features recited in claim 25 (which they do not), it would still not be obvious to combine Lee with Mariotti as argued in the Action. For example, Lee is directed to a media dispenser module for an ATM that has a locking mechanism (described in paragraphs [0035] and [0039] for a first embodiment and in paragraph [0056] to [0059] for a second embodiment). There is no teaching, suggestion, or motivation to include a key lock on the door (20) in addition to the described "secure locking mechanism". Further, the addition of such a key lock would defeat the utility or advantages of Lee's invention. The ATM is designed to automatically slide down (open) the door (20) when media requested by the user is piled on the media mounting portion (12) (Figure 1, paragraphs [0033] to [0036]). Placing a key lock on the door would require each user to have a key. Nowhere do Lee or Mariotti disclose or suggest ATMs which require a physical key to access cash dispensed by the ATMs. Further, providing physical keys to users of the ATM would defeat

the alleged security provided by a key lock, because everyone (including thieves) could have a copy of the key. Although Mariotti discloses a key lock 38, the key of Mariotti is intended to only be used by authorized persons (Column 1, line 10). Neither Lee nor Mariotti discloses or suggests providing an ATM or a vault with a key lock usable by the general public to access dispensed cash.

Thus it would not be obvious to combine Lee with Mariotti as the Office asserts. Further, even if there were a prior art teaching or suggestion to combine Lee and Mariotti as asserted, the claims are not directed to a consumer accessible dispensing mechanism which includes a keylock. Rather the claims are directed to the steps of using a deposit holding container which slides in into and out of a chest of an automated banking machine. Thus the asserted combination of features in Lee and Mariotti does not correspond to the features recited in Appellants' claims.

Further, even if there were a prior art teaching or suggestion to combine features of Lee and Mariotti (which there is not), at best such a combination would only produce an ATM with a vault that includes a key usable to both lock and unlock the vault. This hypothetical combination is not capable of being used to carry out the specific steps associated with the deposit holding container recited in claim, as discussed above.

The applied references do not disclose or suggest each of the features, relationships, and steps recited in the claim and the Office has not established *prima facie* obviousness. Also, as nothing in the cited art discloses or suggests the features, relationships, and steps that are specifically recited in the claim, and because there is no prior art teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants'

invention, it is respectfully submitted that claim 25 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be reversed. It follows that the rejections of claims 26-27 which depend from claim 25 should likewise be reversed.

#### **Claim 26**

Claim 26 depends from claim 25 and recites that the method further comprises a step (e) in which, subsequent to (b) and prior to (c), through operation of the deposit accepting device, the method includes moving at least one item through an opening in the chest and into the interior area of the deposit holding container.

Lee with Mariotti do not disclose or suggest moving an item through an opening of a chest into a deposit holding container after urging the locking mechanism to change from the first state to a second state in which the door will be held closed by the locking mechanism when the door is next moved to the closed position.

As nothing in the applied art discloses or suggests all of the features, relationships, and steps recited in the claim, it is respectfully submitted that the rejection of claim 26 should be reversed.

#### **Claim 27**

Claim 27 depends from claim 25 and recites that the method further comprises a step (e) in which subsequent to (d), the method includes actuating the locking mechanism outside of the chest using a key. Responsive to actuating the locking mechanism the door is moveable from the closed position to the open position. Nowhere does the applied art disclose or suggest actuating

a locking mechanism outside of a chest using a key after urging through engagement with a portion of the automated banking machine, the door of the deposit holding container to move from the open position to the closed position. As nothing in the applied art discloses or suggests all of the features, relationships, and steps recited in the claim, it is respectfully submitted that the rejection of claim 27 should be reversed.

### **CONCLUSION**

Each of Appellants' pending claims specifically recites elements, relationships, and steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for producing the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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(viii)



## CLAIMS APPENDIX

1. A cash dispensing automated banking machine comprising:

a chest;

a cash dispenser in operative connection with the chest;

an acceptor device in operative connection with an outer portion of the chest;

a bracket in operative connection with an inner portion of the chest;

a deposit holding container movably engageable with the bracket, wherein the container comprises:

a reservoir;

a locking mechanism in operative connection with the reservoir, wherein the locking mechanism is operative to change from a locked state to an armed state responsive to a key, wherein the locking mechanism includes a movable portion, wherein when the movable portion is moved, the locking mechanism is operative to change from an armed state to a locked state; and



a door in operative connection with the reservoir, wherein when the locking mechanism is in the armed state, the door is moveable from a closed position to an open position;

wherein when the container is moved into supporting engagement with the bracket:

a first portion of the machine is operative to urge the movable portion of the container to move, whereby the locking mechanism is changed from the armed state to the locked state;

wherein when the locking mechanism is in the locked state and the container is moved out of engagement with the bracket:

a second portion of the machine is operative to urge the door of the container to move from the open position to the closed position, wherein in the closed position, a portion of the door is in operative engagement with the locking mechanism, wherein the locking mechanism in the locked state is operative to prevent the door from moving to an open position.

2. The machine according to claim 1, wherein, when the locking mechanism is in the armed position; the door of the container is in the closed state; and the container is moved into

engagement with the bracket, a third portion of the automated banking machine is operative to urge the door of the container to slide into the open position.

3. The machine according to claim 1, wherein the locking mechanism is operative to accept a key therein, wherein when the key rotates in a first direction, the key is operative to cause the locking mechanism to change to an unlocked state, wherein in the unlocked state, the door is moveable from the closed position to the open position.

4. The machine according to claim 1, wherein the locking mechanism is operative to accept a key therein, wherein when the key rotates in a first direction, the key is operative to cause the locking mechanism to change to an unlocked state, wherein in the unlocked state, the door is moveable from the closed position to the open position, wherein after changing to the unlocked state, when the key rotates in a second direction opposed of the first direction, the locking mechanism is operative to change to the armed state.

5. The machine according to claim 4, wherein after the key is rotated in the first direction within the locking mechanism, the locking mechanism is operative to prevent the key from being removed from the locking mechanism, until the key is rotated in the second direction.

6. The machine according to claim 4, wherein the acceptor device is operative to move to a position above the bracket, wherein the chest includes at least one opening therethrough located adjacent the bracket, wherein the acceptor device is operative to move items through the opening into the container.

7. The machine according to claim 6, further comprising a movable projection, wherein when the container is moved into engagement with the bracket, the container is operative to urge the movable projection into a first position adjacent a portion of the acceptor device, wherein the movable projection in the first position is operative to prevent the acceptor device from moving into a service position, wherein when the container is removed out of engagement with the bracket, the movable projection is operative to move to a second position, wherein the moveable projection in the second position does not prevent the acceptor device from moving into the service position.

8. The machine according to claims 7, wherein when the acceptor device is not in the service position, the acceptor device is positioned above the bracket, wherein when the acceptor device is in the service position, the acceptor device is not directly above at least a portion of the at least one opening through the chest.

9. The machine according to claim 1, wherein the chest has a generally "L" shaped contour with a first taller portion adjacent a second relatively shorter portion, wherein the acceptor device is positioned above the shorter second portion adjacent the first taller portion, wherein the bracket is positioned within the second shorter portion of the chest below the acceptor device, wherein the chest includes an opening between the bracket and the acceptor device, wherein the acceptor device is operative to move items through the opening into the container.

10. The machine according to claim 1, wherein the door of the container includes an upwardly directed projection, wherein when the container is moved into supporting engagement with the bracket the second portion of the machine is operative to contact the upwardly directed projection to urge the door to move into the open position.

11. The machine according to claim 2, wherein the door of the container includes a slot, wherein when the container is moved out of engagement with the bracket, the third portion of the machine is operative to pivot into the slot and urge the door into the closed position.

12. The machine according to claim 1, wherein the container includes a frame, wherein the locking mechanism is mounted in supporting connection with the frame, wherein the frame includes an aperture therethrough adjacent the movable, wherein the first portion includes a pin which is positioned to extend in the aperture and engage the moveable portion when the container is moved into supporting engagement with the bracket.

13. The machine according to claim 1, wherein the door includes a flexible tambour portion which is operative to slide between parallel channels adjacent an opening into the reservoir.

14. The machine according to claim 13, wherein the tambour door includes flanges which are operative to slide within the channels.

15. The machine according to claim 14, wherein each channel includes a frangible portion, wherein the frangible portion is operative to break to provide an opening for inserting one of the flanges of the door into the channel.

16. (original) A method comprising:

- a) urging a deposit holding container to slide adjacent a bracket of an automated banking machine, wherein the automated banking machine includes a cash dispenser, wherein the container includes a locking mechanism, wherein the locking mechanism is in an armed state, wherein the container includes a door, wherein the door is operative to move from a closed position to an open position when the locking mechanism is in the armed state;
- b) urging with a first portion of the automated banking machine the locking mechanism to change to a locked state responsive to (a);
- c) urging the container to slide out of the bracket; and
- d) urging with a second portion of the automated banking machine, the door of the container to move to a closed position responsive to (c), wherein a portion of the door engages with the locking mechanism, wherein the locking mechanism in the locked state is operative to prevent the door from moving to an open position.

17. The method according to claim 16, wherein prior to (a) the door of the container is in the closed position, wherein responsive to (a) urging with a third portion of the automated banking machine the door of the container to slide into the open position.

18. The method according to claim 16, further comprising:

- e) placing a key into engagement with the locking mechanism;
- f) urging with the key the locking mechanism into an unlocked state, wherein the door is operative to move to the open position.

19. The method according to claim 18, further comprising:

- g) removing the key from engagement with the locking mechanism, wherein the locking mechanism is in the armed state.

20. The method according to claim 18, further comprising:

- g) causing with the key, the locking mechanism to change from the unlocked state to the armed state; and
- h) removing the key from engagement with the locking mechanism.

21. The method according to claim 20, wherein between (f) and (g) the key is not removable from the locking mechanism.

22. The method according to claim 20, wherein (f) includes rotating the key within the locking mechanism in a first direction.

23. The method according to claim 22, wherein (g) includes rotating the key in an opposite second direction.

24. A cash dispensing automated banking machine comprising:

a chest in operative connection with a frame, wherein the chest has a generally "L" shaped outer contour with a first taller portion adjacent a second relatively shorter portion, wherein the shorter portion includes an upper face with an opening therethrough;

a cash dispenser in operative connection within the taller portion of the chest;

an acceptor device in operative connection with an outer portion of the chest, wherein the acceptor device is positioned above the shorter portion and adjacent to the first taller portion; and

a deposit holding container in removable connection within the shorter portion of the chest, wherein the acceptor device is operative to move items through the opening into the container.

25. A method comprising:

- a) urging a deposit holding container to slide into a chest of an automated banking machine, wherein the automated banking machine includes a cash dispenser and a deposit accepting device, wherein the deposit holding container includes a locking mechanism and a door controlling access to an interior area of the container, and wherein the locking mechanism is in a first state which permits the door to move from a closed position to an open position, wherein the door is moved from the closed position to the open position responsive to the container sliding into the chest;
- b) responsive to the container sliding into the chest in (a), urging through operative engagement with a portion of the automated banking machine, the locking mechanism to change from the first state to a second state, wherein with the locking mechanism in the second state the door will be held closed by the locking mechanism when the door is next moved to the closed position;
- c) subsequent to (b), urging the container to slide out of the chest; and



- d) responsive to (c), urging through engagement with a portion of the automated banking machine, the door of the deposit holding container to move from the open position to the closed position, wherein when the door has moved to the closed position, the locking mechanism in the second state prevents the door from thereafter moving from the closed position to the open position.

26 The method according to claim 25, further comprising:

- e) subsequent to (b) and prior to (c) through operation of the deposit accepting device, moving at least one item through an opening in the chest and into the interior area of the deposit holding container.

27 The method according to claim 25, further comprising:

- e) subsequent to (d), actuating the locking mechanism outside of the chest using a key, wherein responsive to actuating the locking mechanism the door is moveable from the closed position to the open position.

**(ix)**

## **EVIDENCE APPENDIX**

None.

(x)

**RELATED PROCEEDINGS APPENDIX**

None.